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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/089,442 | 03/29/2002 | Tadashi Mukai | 05273.0034 | 6933 |
| 22852 | 7590 | 06/21/2005 | EXAMINER | |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | SHEIKH, HUMERA N | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1615 | |

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/089,442 | MUKAI ET AL. |
| | Examiner Humera N. Sheikh | Art Unit 1615 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 April 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Status of the Application

Receipt of Applicant's Amendment (to Claims & Specification), Arguments/Remarks, Replacement Abstract and request for extension of time (1 month-granted), all filed 04/13/05 is acknowledged.

Claims 1-8 are pending. Claims 1, 3 and 5-7 have been amended. Claims 1-8 are rejected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruyama *et al.* (EP 0 648 487 A1) in view of Eichel *et al.* (EP 0 391 518).

Maruyama *et al.* teach a stable dispersion of enteric coating agent for the preparation of pharmaceutical compositions comprising an enteric coating base, a plasticizer and an anionic surfactant. The enteric coating base, having an average particle size of not more than 10 µm is dispersed in water in a concentration ranging from 5 to 15% by weight. The ratio of the enteric coating agent, the plasticizer and the anionic surfactant is 100 parts by weight: 15 to 40 parts by weight: 0.1 to 10 parts by weight. The enteric coating base is preferably either hydroxypropyl methyl cellulose phthalate (HPMCP) or hydroxypropyl methyl cellulose acetate succinate (HPMCAS) and the plasticizer is preferably either triethyl citrate or triacetin (see Abstract and page 3, lines 2-20).

The solid enteric pharmaceutical preparation is provided with an enteric coating film for the purpose of protecting drugs showing low resistance to acids from the attack of the acid in the stomach, of protecting the gastric mucous membrane from the attack of the drug and the drug is dissolved after the arrival at the intestines in which the pharmaceutical preparation shows its pharmacological action (pg. 2, lines 3-7).

According to Maruyama *et al.*, the enteric coating bases can be used alone or in combination. The particle size is preferably not more than 10 µm. The plasticizers can also be used alone or in combination. Triethyl citrate is preferred because it ensures highly stable dispersibility of the coating base in an aqueous medium (page 3, lines 21-23).

Examples of anionic surfactants used in the dispersion with the plasticizer include sodium alkyl sulfates, such as sodium lauryl sulfate and sodium dioctyl sulfosuccinate (pg. 3, lines 24-

29). The dispersion of enteric coating agent obtained is used for applying an enteric coating film to solid drugs, such as tablets, granules or capsules (pg. 4, lines 11-12).

The Examples at pages 4-7 demonstrate various stable granule dispersions comprising HPMCP as the enteric coating agent. The data listed in Table 2 clearly indicates that the resulting enteric coating film hardly became soluble in the gastric juice through the addition of an anionic surfactant and that the resistance to acids of the film was substantially improved.

Maruyama *et al.* teach dispersions comprising a combination of enteric coating agents, plasticizers and anionic surfactants. Maruyama *et al.* do not teach an acid in the dispersion.

Eichel *et al.* (EP '518) teach a sustained-release pharmaceutical preparation comprising an admixture of uncoated and/or single walled coated drug and multi-units of microparticles of a multi-walled coated drug. The microparticle structure preferably has a core drug, an inner wall microencapsular enteric coating, such as a cellulose acetate phthalate, a solid *acid*, such as citric acid, adipic acid or an acidic ion exchange resin layered onto or included in the enteric layer, and an outer wall microencapsulated control coating, such as a polymethacrylic acid ester copolymer or ethyl cellulose (see Abstract).

According to Eichel *et al.*, the acid within the enteric coating or the acid layer between the enteric core and control coating impedes drug release by maintaining the enteric material at a low pH.

Suitable acids that preserve the enteric core properties include citric acid, ascorbic acid, adipic acid, ethylene diamine tetracetic acid (EDTA), lactic acid and succinic acid, or polymeric acids and acidic ion exchange resins (pg. 4, lines 21-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the acids taught by Eichel *et al.* within the coating dispersion of Maruyama *et al.* because Eichel *et al.* teach that the acids function to preserve the enteric properties of the core and the acids also impede drug release by maintaining the enteric material at a low pH and similarly, Maruyama *et al.* teach stable, uniform coating dispersions comprising enteric coating bases that protect drugs showing low resistance to acids in the stomach, wherein the drug is dissolved after the arrival at the intestines wherein the pharmacological action occurs. The expected result would be an improved, stabilized and better preserved enterically-formulated coating dispersion.

With regards to the instant drug (cilostazol), the prior art does not explicitly teach cilostazol. However, no criticality is seen in the use of the instant drug, since the prior art clearly teaches coating dispersions for various suitable drugs in tablet, capsule and granular forms. Moreover, the prior art teaches 'aspirin' used as the core drug, which is an anti-platelet drug, as is cilostanzol, and thus similar effects could be obtained if one drug were substituted for the other (see EP '518, pg. 5, line 32). Therefore, the instant invention, when considered as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicant's arguments filed 04/13/05 have been fully considered but they are not persuasive.

Applicant argued, "As recognized by the Examiner, Maruyama et al. does not teach or suggest the incorporation of an acid into the coating dispersion nor the effect thereof. In Eichel et al. it is essential to form a multi-walled coated drug, comprising an inner wall microencapsular enteric coating and an outer wall microencapsulated control coating, and it is the inner wall coating that contains the acid either layered onto it or included in it. In contrast, in Applicant's invention, the acid is incorporated into the dispersion, which forms the coating for the medicament. This enables the coated preparation to deliver the medicament to the lower digestive tract. There is no teaching in Eichel et al. that the acid on or in an inner layer would have this effect if included in the dispersion of Maruyama et al."

Applicant's arguments have been fully considered, but were not persuasive. Admittedly, while Maruyama et al. do not teach an acid in their dispersion, Eichel et al. were relied upon to remedy this only deficiency of Maruyama et al. by teaching the incorporation of an acid in sustained-release pharmaceutical preparations comprising medicaments. Albeit, the acid in the formulation of Eichel et al. is contained in the inner wall coating, however, the secondary reference was relied upon solely to demonstrate the obviousness that it is well known in the art to incorporate acids, such as those taught by Eichel et al. in sustained release, enterically-coated formulations, *per se*. Eichel et al. further teaches acids from the instant selective group of instant claim 4 (i.e., citric, ascorbic, adipic acids, etc.). Moreover, Applicant's argument that the 'acids on the prior art would not provide for effects of the instant invention, such as the delivery of medicament into the lower digestive tract', is not persuasive since the prior art teaches and recognizes drug release, which takes place in the intestines (see, for example, Eichel et al. Abstract).

Applicant argued, "Neither Maruyama et al. nor Eichel et al. teach that the acid be present 'in an amount of from 1 to 10 parts by weight per 100 parts by weight of the hydroxypropyl methylcellulose acetate succinate' as set forth in claim 1. No specific range is mentioned in Eichel et al., as far as the Examples are concerned, the amount is beyond the range claimed; i.e. too much."

Applicant's arguments have been fully considered, but were not persuasive. While the prior art does not teach Applicant's claimed amounts (1 to 10 parts by weight acid per 100 parts by weight HPMAS), the Examiner points out that generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. [W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Applicants have not demonstrated any unexpected and/or unusual results attributed by the claimed acid content. Moreover, the Examiner notes that suitable amounts of acid could be routinely determined by one skilled in the art through the use of routine or manipulative experimentation to obtain optimal results, as these are indeed variable parameters attainable within the art. The prior art initially teaches effective and suitable enterically-coated dispersion formulations comprising similar ingredients, used for the same field of endeavor, to provide for similar effects as those desired by Applicant. Thus, given the teachings of Mauyama et al. and Eichel et al., the instant invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

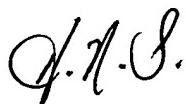
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (571) 272-0604. The examiner can normally be reached on Monday through Friday from 8:00A.M. to 5:30P.M., alternate Fridays off.

Art Unit: 1615

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

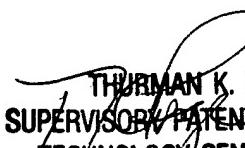
H. N. Sheikh



Patent Examiner

Art Unit 1615

June 13, 2005



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